REMARKS

Claims 90-95, 97-102 and 105-108 are currently pending, of which claims 90, 99 and 105 are in independent form. No claims have been amended hereby.

Favorable reconsideration of the present patent application as currently constituted is respectfully requested.

Regarding the Claim Rejections – 35 U.S.C. §103(a)

Claims 90-95, 97-102 and 105-108 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,958,006 to Eggleston et al. (hereinafter the *Eggleston* reference) in view of U.S. Patent No. 5,826,023 to Hall et al. (hereinafter the *Hall* reference) and in further view of U.S. Patent No. 6,289,105 to Murota (hereinafter the *Murota* reference).

The Office Action has commented as follows with respect to base claim 90:

> The Examiner notes that Eggleston does not explicitly disclose that the reply message has the user's mail box address as its originating address. However, Eggleston discloses that reply messages are received by the communication server, the preceding message is retrieved by the server, and a delta routine is applied to reconstruct a replica of the

reply message. It is clear that the mobile client does not have independent e-mail functionality. Rather, the host server provides the e-mail address and forwards e-mail to recipients who are unaware of any address from the mobile client. Therefore, despite [lack of] explicit disclosure that the reply message has the user's mail box address as its originating address, one of ordinary skill in the art would have understood Eggleston to disclose such a feature in the disclosure discussing Figure 9.

Substantially identical reasons are also relied upon for rejecting the remaining base claims, i.e., claims 99 and 105.

Applicant respectfully disagrees and offers the following discussion as support. *Eggleston* is directed to a "method and apparatus for communicating summarized data." In *Eggleston*, a laptop computer 105 with a wireless modem 106 communicates with a "communication server" 110, which in turn is coupled to a user's "Post Office" host server 115. As set forth in *Eggleston*, communication server 110 includes a virtual session manager 230 and a query manager 231, and is coupled between a data network 130 and the Post Office host/server 115. See Figures 1 and 2. The virtual session manager 230 is provided for establishing and maintaining a virtual session communication path with the mobile station 105 and a session-oriented communication path with the host server 115. As described with

respect to Figure 2, which shows additional details of an exemplary communication server 220, the query manager 231 is designed to send requests to a mail server (i.e., Post Office server) to query for unprocessed messages.

The objective of *Eggleston*'s disclosure is to reduce costs for remote communications. *Eggleston* particularly notes that it is "desirable to limit the amount of information communicated between a remote user and host, both to save off-site user's time and to limit the costs arising from the more expensive rates for remote communications." Column 1, lines 51-54.

In one of the embodiments disclosed in *Eggleston*, a method and apparatus for sending an "optimized reply" is provided. The description of this embodiment is summarized at column 3, lines 35-56, excerpted below for convenience:

In a fourth main embodiment, a method and apparatus for optimized reply to messaging is provided. When sending a reply, the remote communication unit's controller generates a delta (e.g., data representing the content difference between two messages) between a preceding message and the reply message, and forms an optimized reply using the delta and an identifier of the preceding message. On receiving the optimized reply, the communication server uses the data unit identifier to retrieve the preceding message from a further host (e.g., the post office mailbox of the user associated with the remote

unit), reconstructs the full reply from the retrieved
message and the delta, and forwards the full reply to
the addressee. When receiving a reply for the remote
unit, an index is preferably maintained at both the
remote unit and communication server of mail stored at
the remote unit. Resort is made to this index to
determine a preceding message forming part of the
reply. An optimized reply is similarly formed from a
delta and identifying information of the preceding
message, and sent to the remote unit. In this manner,
the volume and expense incurred in reply messaging is
greatly reduced, by only sending a delta and small
header (i.e., the identifying information).

Figure 9 of *Eggleston* shows a flow chart (reproduced below)

for illustrating an "optimized reply embodiment" that is

intended to describe the embodiment in further detail. As set

forth below in detail, Figure 9 of *Eggleston*, however, says

nothing about "configuring" any aspect of a reply mail item to

result in a message wherein the user's first address is

configured as the reply mail item's originating address.

According to the specification of *Eggleston*, the Figure 9

embodiment "permit[s] a user to minimize the data transmitted

for responses to earlier data transmissions." Column 11, lines

35-37. *Eggleston* asserts that this embodiment is particularly

advantageous for e-mail, where the reply message typically

appends all prior messages in an e-mail conversation. See column

11, lines 37-42. Thus, as explained by *Eggleston*, the client formulates a reply to a received mail message, "much as he or she would for any typical email application (step 902)." Column 11, lines 46-49.
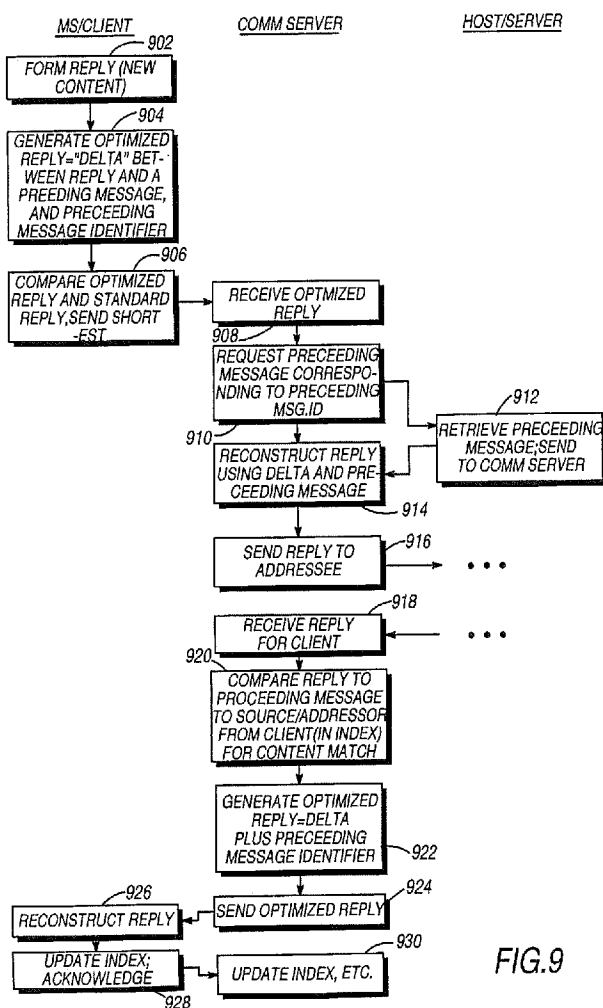
When the user hits the send button the mobile client generates an optimized reply, in part by calculating the delta or difference between the reply message and the preceding message. When the optimized reply is received at the communication server, the communication server 110/220 may "use[] a counterpart delta routine to that of the client to reconstruct a replica of the reply message from the delta of the optimized reply and the retrieved copy of the preceding message." Column 12, lines 55-59.

MS/CLIENT   COMM SERVER   HOST/SERVER

902
FORM REPLY (NEW CONTENT)

904
GENERATE OPTIMIZED REPLY="DELTA" BET-WEEN REPLY AND A PREEDING MESSAGE, AND PRECEEDING MESSAGE IDENTIFIER

906
COMPARE OPTIMIZED REPLY AND STANDARD REPLY,SEND SHORT -EST

RECEIVE OPTMIZED REPLY
908
REQUEST PRECEEDING MESSAGE CORRESPO-NDING TO PRECEEDING MSG.ID

912
RETRIEVE PRECEEDING MESSAGE;SEND TO COMM SERVER

910
RECONSTRUCT REPLY USING DELTA AND PRE-CEEDING MESSAGE
914

SEND REPLY TO ADDRESSEE
916
• • •

RECEIVE REPLY FOR CLIENT
918
• • •

920
COMPARE REPLY TO PROCEEDING MESSAGE TO SOURCE/ADDRESSOR FROM CLIENT(IN INDEX) FOR CONTENT MATCH

GENERATE OPTIMIZED REPLY=DELTA PLUS PRECEEDING MESSAGE IDENTIFIER
922

924
SEND OPTIMIZED REPLY

926
RECONSTRUCT REPLY

930
UPDATE INDEX, ETC.

UPDATE INDEX; ACKNOWLEDGE
928

FIG.9

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The Figure 9 embodiment, however, does not teach configuring the received message such that it is sent with the user's first address associated with the messaging host system as its originating address. There is simply no teaching or suggestion that "optimizing" the reply involves any such effect. Once reconstructed, *Eggleston* merely states that "the reply message is forwarded to the target unit(s), as well as to the outbox or sent mail folder of the client's post office box (steps 914-916)." Column 12, lines 58-62. But forwarding the reply message to the target unit and to the outbox or sent mail folder of the post office box does not teach expressly or inherently anything about *the origin of the message*.

Thus, nowhere does the *Eggleston* reference explicitly describe configuring the user's first address associated with the messaging host system as the reply mail item's originating address, as set forth in Applicant's claims. However, to rely on "inherency" by arguing that because the mobile client in *Eggleston* does not have an e-mail address, the message must appear as if it originates at the user's host address is in error. First, such an argument does not address the question of what "configuration" is specifically practiced on the "reply

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mail item" whereby the user's first address is configured as the reply mail item's originating address. Secondly, the legal standard for inherency is very strict and it is Applicant's position that this standard for inherency is not met by the *Eggleston* disclosure. To inherently describe a missing limitation, a patent disclosure must "necessarily" and "unavoidably" teach the missing limitation. *See Agilent Techs., Inc. v. Affymetrix, Inc.,* 567 F.3d 1366, 1383, 91 USPQ2d 1161, 1172 (Fed. Cir. 2009) ("The very essence of inherency is that one of ordinary skill in the art would recognize that a reference unavoidably teaches the property in question."); *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. Gen. Elec. Co.,* 264 F.3d 1111, 1119, 60 USPQ2d 1017, 1023 (Fed. Cir. 2001) ("In order for a disclosure to be inherent, the missing descriptive matter must necessarily be present in the [original] application's specification such that one skilled in the art would recognize such a disclosure.") (internal quotations omitted). Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Crown Operations Int'l, Ltd. v. Solutia Inc.,* 289 F.3d 1367, 1377, 62

USPQ2d 1917, 1923 (Fed. Cir. 2002) (emphasis added). Nor can inherency be established by "an obvious variant of that which is disclosed in the specification." *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

At least for the foregoing reasons, it is believed that *Eggleston* is deficient when applied as a primary reference against each of the pending base claims. It is clear that the various secondary references (i.e., the *Hall* and *Murota* references) applied in the outstanding Office Action with respect to the pending §103 rejections are of no avail in curing the fundamental deficiencies of *Eggleston*. Accordingly, it is believed that all pending claims are allowable over the art of record.

Reservation of Rights

Notwithstanding the foregoing, Applicant reserves all rights not exercised in connection with this response, such as, e.g., the right to challenge or rebut any tacit or explicit characterization of any reference or of the present claims, the right to challenge any Official Notice(s) taken, the right to challenge or rebut any asserted factual or legal basis of any of the rejections of the present Office Action, or the right to swear behind any cited reference such as provided under 37 C.F.R. §1.131 or otherwise.

Fee Statement

Compared to the highest number previously paid for, the total number of claims and the number of independent claims have not increased.   No request for an extension of the response period is being made.   Accordingly, it is believed that no fees are due for the filing of this response.   If any fees are due or any overpayments have been made, however, please charge or credit our deposit account (Deposit Account No. 03-1130).

SUMMARY AND CONCLUSION

In view of the fact that none of the art of the record, whether considered alone or in combination discloses, anticipates or suggests the present embodiments, as now defined by the independent claims, and in further view of the above amendments and/or remarks, reconsideration of the Action and allowance of the present patent application are respectfully requested and are believed to be appropriate.

Respectfully submitted,

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